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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,610	08/25/2003	Qinbai Fan	GTI-1429-CIP	2842

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EXAMINER	
MERCADO, JULIAN A	
ART UNIT	PAPER NUMBER
1745	

MAIL DATE	DELIVERY MODE
06/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/647,610	Applicant(s) FAN ET AL.	
	Examiner Julian Mercado	Art Unit 1745	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 May 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): None.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: 1-17.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Advisory Action

At the outset, the 35 U.S.C. 112, first paragraph rejection for lack of enablement is maintained for the reasons of record. Applicant has not presented any new arguments for this rejection *per se* and instead appears to rely on coinciding reasons presented against the prior art rejections. To this extent, applicant's arguments filed on May 7, 2007 have been fully considered but are not found persuasive for the following reasons:

Applicant submits that "it is an improper extrapolation of a mere teaching of the presence of nitrogen, without any explicit explanation as to how the nitrogen got into the alloy, to conclude that the nitrogen is intrinsically present in the described alloy." This argument is not persuasive; it is clear that nitrogen is present in the exact amount of 0.02 wt. %. By whatever means or process the nitrogen imbued itself into the composition is not germane to the reference otherwise teaching a positive presence of nitrogen, which is further reinforced by other prior art references (see Sawaragi et al. and Hiramatsu et al.) teaching that nitrogen is intrinsically present.

Applicant submits that the amount indicated to be ".." is indeterminate, presumably because it is so low, as indicated by the Examiner...." In reply, the examiner asserts that it was applicant (and not the examiner) that presumed this amount as being "so low"—so low to the extent that "..." was said to be equal to zero. For the reasons of record, the examiner thus maintains that extrapolating "..." as being equal to zero, as presumed by applicant, is improper.

Applicant submits that "[f]or [the amount indicated by "..."] not to be zero as argued by the Examiner would mean producing a stainless steel having a zero amount of nitrogen is an impossibility since measurement of the difference between an alloy having 0.00 wt.% nitrogen

and an alloy having "..." wt. % alloy is not possible." Applicant further offers to concede that "if the Examiner can show that producing a stainless steel having a zero amount of nitrogen is impossible, then the amount of nitrogen indicated by "..." is not zero." Applicant then notes that "no such evidence has been proffered by the Examiner." These arguments are not persuasive. Applicant's offer to concede an alleged point made by the examiner also appears misdirected—the examiner asserts that prior art previously relied upon has established, *prima facie*, that nitrogen is present, inherently, in austenitic steel alloys. The examiner is of the position, therefore, that if any burden has not been satisfied in either establishing or rebutting a *prima facie* case of obviousness (insofar as an inherency rejection is made under the appropriate section of 35 U.S.C. 102 and/or 103(a)), that burden is presently on applicant.

Applicant submits that "if the Examiner is going to take the position that "..." absolutely does not mean zero when it comes to the amounts of Ni, Mo, S, N, and P present in the stainless steels listed in the ASM reference, the burden is on the Examiner to clearly establish that achievement of a zero amount of each of these elements present in the listed stainless steels is not possible. Applicant has misinterpreted the examiner's position. The examiner has not stated that the amount indicated by "..." absolutely does not mean zero. More precisely, the examiner has asserted that the amount indicated by "..." is not zero is only insofar as this amount is *indeterminate,* and therefore cannot unequivocally be equal to zero, i.e. absolutely equal to zero as otherwise relied upon by applicant. Applicant has yet to establish or satisfy the present *and more relevant* burden of a zero, i.e. 0.00 wt. % nitrogen by weight of the alloy. See the prior Office action on page 6.

The examiner acknowledges applicant's statement on the record that the term "absence of nitrogen in the alloy" as used in the specification is intended to mean "an alloy with *no nitrogen*." (emphasis as submitted on page 10) Applicant is also correct in understanding the examiner's position, e.g. "Applicant must present evidence that the presently claimed austenitic alloy has zero, i.e. 0.00% of nitrogen by weight of alloy", in order to overcome all applied rejections. Applicant then urges that the present response has presented ample evidence of a "zero nitrogen by weight of the alloy...." However, for the foregoing reasons and for reasons already of record, there is no conclusive basis for applicant's claimed "zero nitrogen" as being equal to 0.00 wt. % nitrogen.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

jam

PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER